Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID Y. CHANG

Appeal No. 1998-3383
Application 08/352,662

ON BRIEF

Before HAIRSTON, FLEMING and DIXON, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-10, 12-21 and 23-28. Claims 11 and 22 have been canceled.

The present invention relates to methods and systems for managing processes in a digital computer system through user defined indicia.

The only two independent claims, claims 1 and 12 are reproduced as follows:

1. A method for attaching user defined information to a process object in a data processing system, the method comprising the steps of:

invoking a first process;

creating a control block corresponding to the first process, wherein the control block has system defined process variables that are assigned values by the operating system;

searching for an undefined process variable field in the process control block for the first process, after the first process has been invoked;

if an undefined process variable field is found, defining a User Defined Process Variable in the undefined process variable field; and

assigning a value to a User Defined Process Variable in the control block corresponding to the first process.

12. A data processing system for attaching user defined information to a process object, the data processing system comprising:

means for invoking a first process;

means for creating a control block corresponding to the first process, wherein the control block has system defined process variables that are assigned by values by the operating system;

means for searching for an undefined process variable field in the process control block for the first process, after the first process has been invoked;

means, responsive to locating an undefined process variable field in the process control block corresponding to the first process, for defining a User Defined Process Variable in the undefined process variable field; and

means for assigning a value to a User Defined Process Variable in the control block corresponding to the first process.

The Examiner relies on the following references:

Bristol 5,247,693 Sept. 21, 1993

Stevens, "Advanced Programming in the UNIX Environment", pp. 85-90, 130, 172, 173, 188, 189, 190, 192, 210, 238-240, (1992).

Claims 1-10, 12-21 and 23-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stevens in view of Bristol.

Rather than reiterate arguments of Appellant and Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1-10, 12-21 and 23-28 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the

prior art, or by implications contained in such teachings for suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc**., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc**., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983).

Appellant argues that neither Stevens nor Bristol render the Appellant's invention unpatentable because the combination of those references do not show and suggest each feature recited in the present claims. Appellant argues that the limitation "searching for undefined process variable field in the process control block for the first process, after the first process has been invoked" recited in Appellant's claims 1 and 12 is not met by these references.

Appellant argues on page 8 of the brief that the definition of the term "undefined" must be given special

meaning consistent with the specification. Appellant points to page 11, line 15 et seq., which defines the term "undefined" to mean a process variable field lacking both name and value. Appellant argues therefor the term "undefined" is not met by Bristol's valueless but named variables.

On page 9 of the brief, Appellant further argues that the combination of Stevens and Bristol fails to show or suggest the limitation of "if an undefined process variable field is found, defining a User Defined Process Variable in an undefined process variable field" as recited in claim 1. We note that claim 12 also has similar language. Appellant argues that the term "User Defined Process Variable" has been defined in the specification to have two characteristics: (1) it is user defined (i.e., not system defined like system defined process variable): and (2) it is a variable of a process and is therefor defined in the process control block. Appellant argues that the Examiner's finding that the Stevens CHMODN FCHMOD functions do not read on User Defined Process Variable as defined by Appellant's specification because the

Stevens functions change the file access permission of an existing file and a file is not a process.

Appellant argues that a file access permission is not a process variable as recited in Appellant's claims 1 and 12.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed Cir. 1998). Moreover, when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. **Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.** 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840. Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. **In re Paulsen**, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Upon our review of Stevens and Bristol and in view of the Appellant's special meaning to the claimed terms "undefined"

and "User Defined Process Variable", we find that neither Stevens nor Bristol teach these limitations. We note that the Examiner must accept the interpretation of these limitations in a manner consistent with Appellant's specification and with the ordinary usage of the terms in the computer operating system art.

Appellant argues that the Examiner's combination of Stevens and Bristol is not proper. Appellant argues that it is the burden of the Examiner to explain why the combination of the teachings is proper. Appellant argues that the Examiner does not cite any particular knowledge that is generally available to a person of ordinary skill in the art at the time the invention was

made that might form a basis for the Examiner's combination of cited references.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84

n. 14 (Fed. Cir. 1992), **citing In re Gordon**, 733, 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40(Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellant. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing**

W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We note that the Examiner has provided the reason that it would have been obvious to improve upon the process variables as taught by Stevens by defining a user defined process variable in an undefined process variable field of a process that has already been invoked because it would provide Stevens' system with enhanced capability of allowing clear execution of various otherwise inaccessible service functions. However, we note that the Examiner has failed to answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art would have reasonably expected to use the solution which is claimed by the Appellant. We note that the Examiner's general assertion to combine these references without more does not provide an adequate basis for the Examiner's

combination of the references.

In view of the foregoing, we have not sustained the rejection of claims 1-10, 12-21 and 23-38 under 35 U.S.C. § 103.

Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

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